

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH MITCHELL SZETTELLA,
JEFFERY OZEE and AUGUSTO JAMES GONZALES

Appeal No. 2002-1228
Application No. 09/124,831

HEARD: August 13, 2002

Before ABRAMS, McQUADE, and BAHR, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-10 and 18-23. Claims 11-17 have been withdrawn by the examiner as being directed to a non-elected invention.

We REVERSE.

BACKGROUND

The appellants' invention relates to a method of mounting an electrode assembly on a plasma etching apparatus. An understanding of the invention can be derived from a reading of exemplary claims 1 and 18, which appear in the appendix to the Revised Appeal Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Collignon	3,979,994	Sep. 14, 1976
White	5,004,017	Apr. 2, 1991

Appellants' admitted prior art as set forth in the specification at page 1, line 10 to page 2, line 4 (AAPA).

Claims 1, 3, 7, 10, 18, 19 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over White in view of AAPA.

Claims 2, 4-6, 8, 9, 20, 21 and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over White in view of AAPA and Collignon.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (Paper No. 17) for the examiner's complete reasoning in support of the rejections, and to the Revised Brief (Paper No. 16) and Reply Brief (Paper No. 18) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Both of the rejections are under 35 U.S.C. § 103. The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

The first of the rejections is that claims 1, 3, 7, 10, 18, 19 and 22 are unpatentable over White in view of AAPA. It is the examiner's view that the method steps recited in these claims are disclosed in White, which is directed to joining together under water a pair of flanged pipe sections, but it would have been obvious to one of

ordinary skill in the art to utilize the White method to mount an electrode assembly on a plasma etching device in view of the admission made by the appellants in the AAPA that it was “old and notoriously well known in the art to mount and align an electrode assembly to a plasma etching apparatus, visually” (Answer, page 4). The examiner, although apparently feeling compelled to cite the AAPA in order to support the rejection, opined that the electrode assembly and the plasma etching apparatus were “intended use limitations and are not deemed to patentably further limit the claimed mounting and alignment process” (Answer, page 3). The appellants argue that the preambles cannot be discarded in evaluating the patentability of the claims, that White is not analogous art, and that even if it were considered to be so, there would have been no suggestion to one of ordinary skill in the art to combine the references in such a manner as to meet the terms of the claims in the absence of hindsight.

Independent claim 18 sets forth “[a] method of mounting an electrode assembly on a plasma etching apparatus” comprising “placing alignment pins inserted in apertures in said plasma etching apparatus through corresponding apertures in said electrode assembly.” Independent claim 1 sets forth this method in somewhat different terms, and adds the step of replacing each of the alignment pins with a fastener.

White is directed to joining the flanged ends of pipe together under water. The method disclosed comprises initially installing upon the flange of a first pipe a plurality of flange stabilizing elements (10, 12) extending outwardly from the periphery of the

flange parallel to the axis of the pipe, and also installing a plurality of alignment stubs (13) extending through several of the bolt holes in the flange. The second pipe is then lowered until its flange rests upon the stabilizing elements, and subsequently is moved laterally toward the first flange and then rotated until the alignment stubs are received in the bolt holes of the second flange. Once the pipe flanges are aligned in this fashion, bolts are installed and the stabilizing elements and alignment stubs are removed. See columns 5 and 6 and Figures 11-16. Thus, White fails to teach that the method of aligning pipe ends under water disclosed therein also is suitable, in whole or in part, to align elements or apparatus other than pipe flanges under water and, as explained below, the particular sequence of steps recited in the appellants' claims.

The extent of the teaching provided by AAPA is that poor etch uniformity results when electrode assemblies are not properly aligned on the plasma etching apparatus and that, in the appellants' view, the prior art methods such as visual alignment have deficiencies which result in poor alignment of these components.

At the outset, we agree with the appellants that the recitations in the preambles of these method claims are not merely statements of intended use but provide antecedents for establishing the terms and limits of the claimed methods (Revised Brief, page 12). This being the case, even considering, arguendo, that White is analogous art, we fail to perceive any teaching, suggestion or incentive in either White or AAPA which would have motivated one of ordinary skill in the art to select, from the

myriad of techniques present in the prior art for aligning one element or apparatus with another, two of the steps of the White method of aligning pipe flanges under water as a method of mounting an electrode assembly on a plasma etching apparatus. Moreover, as we understand the claimed methods from the language of the claims and from pages 3 and 7 of the specification and 3 and 8 of the Revised Brief, the alignment pins are inserted into apertures specified in one of the two elements, namely, the plasma etching apparatus, and then are passed through corresponding apertures in said electrode assembly. This sequence of steps clearly is not suggested by the prior art relied upon. From our perspective, the only suggestion for combining the applied references in the manner proposed by the examiner is found in the luxury of the hindsight provided one who first viewed the appellants' disclosure. This, of course, is not a proper basis for a rejection under Section 103. In re Fritch, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

The combined teachings of White and AAPA thus fail to establish a prima facie case of obviousness with regard to the subject matter recited in independent claims 1 and 18. This being the case, we will not sustain the rejection of these claims or of claims 3, 7, 10, 19 and 22, which depend therefrom.

Claims 2, 4-6, 8, 9, 20, 21 and 23 stand rejected on the basis of White and AAPA, taken further in view of Collignon, which is cited for teaching the features added

by these dependent claims. Be that as it may, Collignon fails to alleviate the deficiencies in White and AAPA which we discussed above. We therefore also will not sustain this rejection.

CONCLUSION

Neither rejection is sustained.

The decision of the examiner is reversed.

NEAL E. ABRAMS
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES
)
)
)
)
)

NEA/LBG

Appeal No. 2002-1228
Application No. 09/124,831

Page 9

RADAR, FISHMAN & GRAUER, PLLC
1233 20TH STREET, N.W., SUITE 501
WASHINGTON, D.C. 20036

APPEAL NO. 2002-1228 - JUDGE ABRAMS
APPLICATION NO. 09/124,831

APJ ABRAMS

APJ McQUADE

APJ BAHR

DECISION: **REVERSED**

THREE JUDGE CONFERENCE

Prepared By: Lesley Brooks

GAU: 3700

OB/HD

DRAFT TYPED: 15 Sep 03

FINAL TYPED: